

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/544,950	10/18/95	ROSE	D DR0951.APP

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E5M1/1122

EXAMINER

WOLFF, J

ART UNIT

PAPER NUMBER

2512

5

DATE MAILED:

11/22/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/544,950

Applicant(s)

ROSE

Examiner

John H. Wolff

Group Art Unit

2512☒ Responsive to communication(s) filed on AMENDMENT A, FILED ON 10/16/96☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 1-32 is/are pending in the application.Of the above, claim(s) 10-16 and 20-30 is/are withdrawn from consideration.☐ Claim(s) _____ is/are allowed.☒ Claim(s) 1-9, 17-19, 31, and 32 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.**Application Papers**☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.☐ received in Application No. (Series Code/Serial Number) _____.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☒ Notice of References Cited, PTO-892☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1 1/2☐ Interview Summary, PTO-413☒ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

2. Claims 10-16, 20-27, 28-30 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention. Election was made **without** traverse in Paper No. 4.

3. An action on the merits on claims 1-9, 17-19 and 31-32, directed to the elected invention defined in Group I, is forwarded herewith.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

6. The patent ABSTRACT should be revised so as to provide a concise statement of the technical disclosure of the patent and

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include that which is new in the art to which the invention pertains.

7. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

8. Claims 1-9, 17-19 and 31-32 are rejected under 35 U.S.C. § 103 as being unpatentable over Smith (5,107,099).

The preamble to claim 1 reads on reference figures 5-7 and the explanation thereof. The body of this claim deals with a data card having three layers which are respectively shown by reference card 16, its magnetizable layer 18, and the protective overcoat layer, see columns 2-3 of Smith. The second layer or magnetizable layer of Smith is shown as covering 'substantially all of the surface layer of a first side of said first layer', as

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claimed. For the indicated reasons claim 1 would have been obvious, at the time the invention was made, to a person of ordinary skill in the art.

Insofar as the limitations in claims 2-4 are disclosed they amount to considerations well within the state of the art and would have been obvious to a skilled person at the time the invention was made. Merely note that a storage capacity of 'approximately 0.75 megabytes' is broad in scope and the reasonable interpretation which this range warrants^{makes it obvious} Nor is there any disclosed basis whereby the recited storage capacity in claim 2 should be viewed as involving either an unexpected or unobvious advance over the state of the art. The first and third layer of claims 3-4 are likewise obvious since the use of 'paper' can hardly be viewed as being unobvious. Claims 5-9 set forth that both sides of a data card are adapted for use in the claimed environment - but data cards, as for example magnetic disks are typically suitable for use on both major surfaces and to do so is well known. These claims fail to add unobvious subject matter to the structure shown to be otherwise old and well known.

The adapter of claim 31 does not define over the presence and application of tray 46 in Smith. This claim would have been obvious in view thereof.

Claims 17-19 and 32 are rejected for substantially similar reasoning. The enumerated step(s) of 'affixing' the recited

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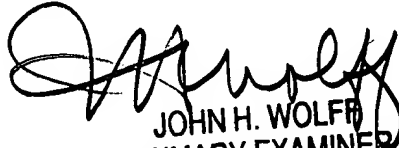
layers in the indicated sequence is obvious as well as necessary for the Smith data card to function as envisioned.

For the reasons indicated the claims of record would have been obvious to a person skilled in this art and having the reference to Smith before him/her.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John H. Wolff whose telephone number is (703) 308-3215.

JHW
November 13, 1996


JOHN H. WOLFF
PRIMARY EXAMINER
GROUP 2500